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10/045,143	01/15/2002	Jui-Chan Sung	MR929-737	8874

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,143

Applicant(s)

SUNG, JUI-CHAN

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase “whereby an object with the adhesive strip can be hanged on a surface with a adhesive strip” is indefinite. It is unclear whether the adhesive strip on the surface is the same type of adhesive strip as the adhesive strip claimed in the preamble and whether the adhesive strip as claimed and the “second” adhesive strip are integrally connected (as in Fig. 4). As currently phrased, two adhesive strips need not be in contact with one another to be in accordance with the Applicant’s claimed invention. Furthermore, although the Applicant may be his own lexicographer, the use of the phrase “a adhesive strip” as used in the aforementioned phrase is confusing because it is unclear whether it is actually a separate adhesive strip. The Examiner suggests rewording “a adhesive strip” to something such as “a second adhesive strip” to facilitate clarity. Proper clarification and/or correction are required.

3. The term "flexible" in claim 1 is a relative term which renders the claim indefinite. The term "flexible" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How flexible must the base plate be to be in accordance with the Applicant’s claimed invention? Proper clarification and/or correction are required.

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4. Claim 1 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrases “adapted to” (on line 2) and “can be” (on lines 7 and 8) are indefinite. The Examiner suggests rewording the preamble of the claim with “An adhesive strip for suspending and hanging an object on a surface” to facilitate clarity. The Examiner further suggests rewording lines 6-7 to read “the adhesive strip is attachable to a surface or an object” to facilitate clarity. Finally, the examiner suggests rewording the “can be” phrase in line 8 with a means-plus function (see MPEP 2181-2184) such that the functional language is given patentable weight. This may be done, for example, by modifying the entire claim to read as follows:

“An adhesive strip for suspending and hanging an object on a surface, the adhesive strip comprising:

a base plate made of flexible material;

an adhesive layer attached to one side of the base plate wherein the adhesive strip is attachable to a surface or an object; and

at least one fin means for integrally connecting an adhesive strip attached to an object with a fin portion of a second adhesive strip attached to a surface or integrally connecting an adhesive strip attached to a surface with a fin portion of a second adhesive strip attached to an object, wherein the at least one fin is attached to the base plate on the side opposite the adhesive layer, and wherein the adhesive strip and the second adhesive strip are congruently shaped.”

Note that this is a rough example but would be in accordance with 35 U.S.C. 112, sixth paragraph. Proper clarification and/or correction are required.

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5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, for the use of parenthetical numbers in describing the separate parts of the invention. The Claims must be particularly and distinctly worded such that one of ordinary skill in the art may ascertain the Applicant's claimed invention without reference to the drawings. The Examiner suggests deleting the parenthetical numbers. Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Arakawa et al. (#5,603,145).

Arakawa et al. disclose an adhesive strip for suspending and hanging an object on a surface, the adhesive strip comprising a base plate made of a flexible material (Col. 2, lines 57-64), multiple fins attached to one side of the base plate wherein the fins are separated and parallel from one another (Figs. 2, 4, and 7-11), and an adhesive layer attached to the other side of the base plate so that the adhesive strip is attachable to a surface or an object (Col. 4, lines 11-20), whereby an object with the adhesive strip is hung on the surface with an adhesive strip (Col. 4, lines 31-33 and Col. 6, lines 63-64).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145) in view of Brumlik (#4,198,734).

Arakawa et al. teach an adhesive strip as detailed above. Although Arakawa et al. teach that the fins project from the surface at an angle between 10 and 80 degrees (Col. 3, lines 35-40) and that there are no particular restrictions on the form or size of the fins (Col. 3, lines 24-25), Arakawa et al. fail to explicitly teach fins with rough contact faces, fins with enlarged and/or capped heads at the distal end of the fin, or saw-toothed contact faces.

Brumlik, however, teach a functional equivalence between fins as taught by Arakawa et al. and fins with enlarged (capped) heads, rough contact surfaces, and saw-toothed contact faces (see Figs. 1(a-b) and 3(a-i)). Brumlik teaches the use of a capped end for the purpose of providing a contact surface with dual-action self-gripping means, the use of the saw-toothed fin for the purpose of aiding in the penetration into the receiving substrate, and the use of the rough contact face for the purpose of providing a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions (see Col. 4, lines 8-44). Thus, depending on the desired end product, it would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified the fins of an adhesive strip with functionally equivalent shapes and/or materials

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for the purpose of providing the adhesive strip with either dual-action self gripping means, aiding in the penetration into the receiving substrate, or providing a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions as taught by Brumlik.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Arakawa et al. by using functionally equivalent fin shapes and/or materials as taught by Brumlik in order to provide the adhesive strip with either dual-action self gripping means, aid in the penetration into the receiving substrate, or to provide a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions.

10. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145).

Arakawa et al. teach an adhesive strip as detailed above. Arakawa et al. teach the use of an adhesive layer and teach a non-limiting example wherein styrene type pressure sensitive adhesive is used (Col. 5, lines 27-29) and wherein the adhesive layer is covered by a protective layer (Col. 4, lines 18-20). Arakawa et al. fail to explicitly teach the use of glue as the adhesive layer. It is noted, however, that Arakawa et al.'s disclosure of adhesive is interpreted by the Examiner to broadly encompass all forms of adhesive and therefore includes glue. Furthermore, even if the Applicant contends otherwise, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to have selected glue as the adhesive layer, since it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

11. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145) in view of Bries et al. (#6,001,471).

Arakawa et al. teach an adhesive strip as detailed above. Although Arakawa et al. teach the use of an adhesive tape (Col. 5, line 29), it is unclear whether this tape is regarded as a double-sided tape as claimed by the Applicant.

Bries et al., however, teach the use of a double-sided adhesive tape for a hook-type fastener (see Abstract; see also Fig. 4). Bries et al. teach the use of a double-sided adhesive tape for the purpose of providing a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have provided an adhesive strip with a double-sided adhesive tape for the purpose of providing a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to as taught by Bries et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Arakawa et al. by using a double-sided pressure sensitive adhesive tape as taught by Bries et al. in order to provide a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE

May 12, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1972 5/13/03